DETAILED ACTION

Claim Objections

1.   Claim 34 is objected to because of the following informalities: It appears that "The computer program product" (line 1) was intended to be --A computer program product--, which change will be assumed for purposes of further consideration of the claims, as to the merits, hereinbelow. Appropriate correction (or clarification) is required.

2.   Claims 33 and 34 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

The test as to whether a claim is a proper dependent claim is that it shall include every limitation of the claim from which it depends (35 U.S.C. 112, fourth paragraph), or, in other words, that it shall not conceivably be infringed by anything which would not also infringe the basic claim.

When, as here, an independent claim recites a particular method, a dependent claim drawn to an apparatus capable of performing the method of the independent claim is not a proper dependent claim if the apparatus might be used in other ways, since the dependent claim (the apparatus) could conceivably be infringed without infringing the basic claim (the method), in violation of the infringement test for proper dependency of claims. See MPEP § 608.01(n)(III).

Applicant is required to cancel the claim(s), amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim Rejections - 35 USC § 101

3.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4.   Claim 33 is rejected under 35 U.S.C. 101 because the claimed invention is

directed to non-statutory subject matter.

Claim 33 is drawn to a computer program per se. Computer programs per se

intrinsically require no tangible physical structure, thus do not constitute tangible

physical articles or other forms of matter. Therefore, computer programs per se are not

considered to be statutory subject matter. To be statutory, a computer program must

be: (1) coupled with or combined with some statutory physical structure, and,

(2) produce or effect some useful, concrete, and tangible result.

Claim Rejections - 35 USC § 102

1.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

2.   .Claims 17-25, 27, 29, 30, and 32 are rejected under 35 U.S.C. 102(b) as being

anticipated by Behr (Foreign Patent Application No DE19954609).

In regards to claims **17** and **27**, Behr discloses a device and method for comparing

calculations for product components in different product types, the device comprising:

an electronic product type listing of a plurality of product types (see in particular page 3,

lines 38-42); an electronic parts lists valid for each product type in the product type

listing and including a breakdown of a product of the product type into a plurality of

components and including at least one feature of each component (see for example

page 2. lines 40-47) ; an electronic component description database including a plurality

of automatically analyzable component descriptions for each component occurring in

the parts list, each component description corresponding to at least one of the plurality

of components and being valid for at least one product type in the product type listing

and including at least one characteristic of the at least one feature (see in particular

page 2, lines 54-61) ; an electronic calculation database having calculations

corresponding to a component occurring in the parts list and to a product type in the

product type listing (see for example page 3, lines 33-42) ; a component selecting unit

configured to select at least one component occurring in the parts list (see for example

page 2. lines 12 and 54-61); a determining unit configured to automatically determine all

calculations in the calculation database relating to a selected component and configured

to determine the product types of the determined calculations (see for example page 3,

lines 38-42); and a comparison unit configured to generate a comparison of a plurality of determined calculations and the component descriptions in effect for a selected component and for determined product types (see in particular page 3, lines 43-48).

In regards to claim **18**, Behr discloses the device as recited in claim 17, wherein: the parts list includes a further breakdown of each component into one or more parts (see in particular page 2, lines 41-45); at least one calculation in the calculation database includes information about a percentage of a part in the calculation of a respective component (see for example page 7, lines 43-44); the comparison unit is configured to generate a partial comparison for each part of the selected component, wherein each partial comparison includes the percentage of the part of the calculation of the comparison(see in particular page 6, lines 33-37).

In regards to claim **19**, Behr discloses the device as recited in claim 18, wherein the comparison unit is configured to generate a configuration comparison of the characteristics of the features of the parts in the product types and configured to insert the configuration comparison into the comparison (see for example page 2, lines 45-49).

In regards to claim **20**, Behr discloses the device as recited in claim 17, further comprising: a product type selecting unit configured to select product types occurring in the product type listing (see for example page 2, lines 12 and 54-61), and wherein the

determining unit is configured to determine all calculations relating to a selected component and a selected product type (see in particular page 3, lines 38-42).

In regards to claim **21**, Behr discloses the device as recited in claim 17, wherein the calculations relate to costs and further comprising an electronic cost type list including a plurality of cost types for each calculation, the cost type list being valid for all components of the parts list and all product types of the listing, wherein each calculation includes a partial calculation for each cost type in the cost type list, and wherein the comparison unit is configured to break down a comparison into the cost types of the cost type list. (see for example page 3, lines 38-42).

In regards to claim **22**, Behr discloses the device as recited in claim 21, further comprising a cost type selecting unit configured to select at least one cost type occurring in the cost type list and wherein the comparison unit is configured to automatically remove cost types not selected from the comparison (see for example page 8, lines 45-48).

In regards to claim **23**, Behr discloses the device as recited in claim 21, further comprising: a calculation selecting unit configured to select a calculation contained in the comparison for each cost type of the cost type list (see in particular page 3, lines 38-42); and a cost type calculation unit configured to generate a calculation for a selected

component, each calculation having a partial calculation for a respective cost type of the cost type list, the partial calculation for a cost type being equal to the partial calculation of the calculation selected for the cost type (see for example page 5, lines 30-36).

In regards to claim **24**, Behr discloses the device as recited in claim 17, further comprising: an electronic attribute list having attributes assignable to the calculations and having possible values of the attributes, the attribute list being valid for all components of the parts list and all product types of the listing, wherein the calculations in the calculation database include attribute-attribute value pairs, each attribute occurring in the attribute list and each attribute value being a possible value of the attribute; and an attribute selecting unit configured to select at least one attribute of the attribute list and one possible value of a selected attribute, wherein the determining unit is configured to automatically determining all calculations including at least one selected attribute-attribute value pair (see in particular page 2, lines 55-65).

In regards to claim **25**, Behr discloses the device as recited in claim 24, wherein the attribute list includes at least one of the following attributes: a period of time to which the calculation refers; a material used to manufacture at least one product component; a supplier of at least one product component; a manufacturing method used in the manufacture of at least one product component; a resource used in the manufacture of at least one product component; and a region in which at least one product component is manufactured (see in particular page 2, lines 55-65).

In regards to claim **29**, Behr discloses the method as recited in claim 27, wherein the calculations refer to costs and further comprising: providing an electronic cost type list having cost types of a calculation, the cost type list being valid for all components and all product types, wherein the determining of the set of calculations includes determining one partial calculation for each cost type of the cost type list; selecting a calculation for each cost type of the cost type list; and generating a further calculation for the selected component having a partial calculation per cost type of the cost type list, the partial calculation of the selected calculation for the cost type being used the cost type in the further calculation (see for example page 3, lines 38-42 and page 5, lines 30-36) .

In regards to claim **30**, Behr discloses a method for comparing calculations for product components in different product types, the method comprising: providing an electronic product type listing of a plurality of product types, each product type corresponding to one or more products, providing an electronic attribute list containing attributes of a calculation and possible values of the attributes, the attribute list being valid for all components and all product types of the listing (see in particular page 2, lines 50-53); providing an electronic parts list valid for each product of the product types of the listing, and including a breakdown of each product into a plurality of components and at least one features of each component (see in particular page 2, lines 41-45); saving automatically analyzable component descriptions for each component occurring in the

parts list in an electronic description database, each component description being valid

for at least one product type occurring in the listing and including characteristics of the

features of the component in this product type (see for example page 2, lines 54-61),

saving calculations relating to at least one component occurring in the parts list and at

least one product type occurring in the product listing, and assigning attribute-attribute

value pairs comprising attributes and attribute values of the attribute list in an electronic

calculation database (see for example page 3, lines 33-42); selecting at least one

attribute of the attribute list and at least one possible value of a selected attribute;

determining a set of the calculations saved in the calculation database to which a

selected attribute-attribute value pair is assigned; determining a set of component

descriptions that are valid for the component and for the product types corresponding to

the set of calculations (see for example page 2, lines 60-65); and generating a

comparison of the set of calculations and the set of component descriptions (see for

example page 3, lines 43-48).

In regards to claim **32**, Behr discloses The method as recited in claim 30, wherein the

attribute list comprising possible attributes of a calculation includes at least one of the

following attributes: a period of time to which the calculation refers; a material used to

manufacture at least one product component; a supplier of at least one product

component; a manufacturing method used in the manufacture of at least one product

component; a resource used in the manufacture of at least one product component; and

a region in which at least one product component is manufactured (see in particular

page 2, lines 55-65).

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4.   The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

> 1.   Determining the scope and contents of the prior art.
> 2.   Ascertaining the differences between the prior art and the claims at issue.
> 3.   Resolving the level of ordinary skill in the pertinent art.
> 4.   Considering objective evidence present in the application indicating obviousness or nonobviousness.

5.   Claims 26, 28, 31, 33, and 34 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Behr (Foreign Patent Application No DE19954609) as applied to

claims 17 and 27 above, and further in view of Ohara et al. (US Patent Publication No

2002/0143418).

Regarding claim **26**, Behr discloses the device as recited in claim 17, further

comprising: a calculation unit configured to generate the calculations using the

electronic parts list, but does not explicitly disclose a memory unit configured to save the calculations in the calculation database.

However, Ohara et al. teach the device as recited in claim 17, but does include the memory unit configured to save the calculations in the calculation database (see in particular paragraph [0031]).

Therefore, it would have been obvious to a person of ordinary skill in the art, at the time of the invention, to implement a memory unit in the device as disclosed by Behr, because enabling the device to store cost and part data would reduce time taken to reenter product data that had already been calculated, and would enable the user to query past information from within the database, thereby reducing processing time.

Regarding claim **28**, Behr discloses the method as recited in claim 27, but does not explicitly disclose the method as recited in claim 27, wherein the saving, selecting, determining and generating steps are performed using a data processing system. However, Ohara et al. does teach the method recited in claim 27, wherein the saving, selecting, determining and generating steps are performed using a data processing system (see in particular paragraph [0019]).

Therefore, it would have been obvious to a person of ordinary skill in the art, at the time of the invention, to perform the steps of saving, selecting, determining, and generating using a data processing system, because implementing the steps using a data

processing system would enable a computer system to perform the method steps, effectively reducing the amount of time necessary to perform product cost comparisons.

Regarding claim **31**, Behr discloses the method as recited in claim 30, but does not explicitly disclose the method as recited in claim 27, wherein the saving, selecting, determining, and generating steps are performed using a data processing system. However, Ohara et al. does teach the method recited in claim 27, wherein the saving, selecting, determining and generating steps are performed using a data processing system (see in particular paragraph [0019]).

Therefore, it would have been obvious to a person of ordinary skill in the art, at the time of the invention, to perform the steps of saving, selecting, determining, and generating using a data processing system, because implementing the steps using a data processing system would enable a computer system to perform the method steps, effectively reducing the amount of time necessary to perform product cost comparisons.

Regarding claim **33**, Behr does not explicitly disclose a computer program product that is directly loadable into the internal memory of a computer and includes software segments configured to implement the method as recited claim 27 when the product runs on a computer.

However, Ohara et al. does teach a computer program product that is directly loadable into the internal memory of a computer and includes software segments configured to

implement the method as recited claim 27 when the product runs on a computer (see in particular paragraph [0052]).

Therefore, it would have been obvious to person of ordinary skill in the art, at the time of the invention, to implement the method as recited in claim 27 on a computer program product that is directly loadable into the internal memory of a computer and includes software segments configured to implement the method when the product runs on a computer, because the ability to download the program onto a computer system will enable the user to utilize the method as recited in claim 27 on any computer that is capable of loading a computer program.

Regarding claim **34**, Behr does not explicitly disclose the computer program product saved on a computer-readable medium and having computer-readable program means causing the computer to execute a method as recited in claim 27.

However, Ohara et al. does teach disclose the computer program product saved on a computer-readable medium and having computer-readable program means causing the computer to execute a method as recited in claim 27 (see for example paragraph [0052])..

Therefore, it would have been obvious to person of ordinary skill in the art, at the time of the invention, to implement the method as recited in claim 27 on a computer program product saved on a computer-readable medium and having computer-readable program means causing the computer to execute a method as recited in claim 27, because the

ability to execute the program onto a computer system will enable the user to utilize the

method as recited in claim 27 on any computer that is capable of executing a computer

program.

Conclusion

6.　　The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

　　Dutra et al. (US Patent Publication No 2003/0154111) discloses an automotive

collision repair claims management method and system.

　　Chen et al. (US Patent No 5,504,674) discloses an insurance claims estimate,

text and graphics network and method.

　　Any inquiry concerning this communication or earlier communications from the

examiner should be directed to TALIA CRAWLEY whose telephone number is (571)

270-5397. The examiner can normally be reached on Monday to Thursday eight to five.

　　If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Jerry O'Connor can be reached on (571) 272-6787. The fax phone number

for the organization where this application or proceeding is assigned is (571) 273-8300.

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